THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 28

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

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Ex parte ROBERT LISTOU

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Appeal No. 1999-2716
Application 08/561,178

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HEARD: AUGUST 15, 2000

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Before JERRY SMITH, FLEMING and RUGGIERO, Administrative Patent Judges.

JERRY SMITH, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on the appeal under 35 U.S.C. § 134 from the examiner's rejection of claims 2-9, 11-18 and 20-22, which constitute all the claims remaining in the application.

The disclosed invention pertains to the field of

sorting and displaying text data objects using a computer system. More particularly, the invention is directed to the simplification of the process by which a user designates parameters associated with the text data objects and the order in which the parameters are sorted.

Representative claim 20 is reproduced as follows:

20. A method for using a computer system to sort and display text data objects, comprising the steps of:

a. imaging, on a display device controlled by the computer system, a query dialog box,

wherein the query dialog box displays each of a plurality of parameters associated with each of the text data objects, forms a plurality of spaces for listing values associated with each displayed parameter, and further forms a space for selecting a sort order;

b. designating, for each displayed parameter, a parameter value;

c. constructing a sort order from the displayed parameters in the space for selecting a sort order;

d. selecting, using the computer system, text data objects satisfying the designated values; and

e. sorting, using the computer system, the selected text data objects according to the constructed sort order.

The examiner relies on the following reference:

Microsoft Project for Windows Feature Guide, Version 1.0, 1990 by Microsoft Corporation, pages v, 22-33, 48-57, 85-95, 110-111 and 137 (Feature Guide).

Claims 2-9, 11-18 and 20-22 stand rejected under 35 U.S.C. § 103. As evidence of obviousness the examiner offers the Feature Guide taken alone.

Rather than repeat the arguments of appellant or the examiner, we make reference to the briefs and the answer for the respective details thereof.

OPINION

We have carefully considered the subject matter on appeal, the rejection advanced by the examiner and the evidence of obviousness relied upon by the examiner as support for the rejection. We have, likewise, reviewed and taken into consideration, in reaching our decision, the appellant's arguments set forth in the briefs along with the examiner's rationale in support of the rejection and arguments in rebuttal set forth in the examiner's answer.

It is our view, after consideration of the record before us, that the evidence relied upon and the level of

skill in the particular art would not have suggested to one of ordinary skill in the art the obviousness of the invention as set forth in claims 2-9, 11-18 and 20-22. Accordingly, we reverse.

Appellant has nominally indicated that for purposes of this appeal the claims will stand or fall together in the following two groups: Group I has claims 20-22, 5-9 and 14-18, and Group II has claims 2-4 and 11-13. Consistent with this indication appellant has made no separate arguments with respect to any of the claims within each group. Accordingly, all the claims within each group will stand or fall together. Note In re King, 801 F.2d 1324, 1325, 231 USPQ 136, 137 (Fed. Cir. 1986); In re Sernaker, 702 F.2d 989, 991, 217 USPQ 1, 3 (Fed. Cir. 1983). Therefore, we will consider the rejection against claims 20 and 2 as representative of all the claims on appeal.

In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the examiner to establish a factual basis to support the legal conclusion of obviousness. See In re Fine, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the examiner is expected to make the factual

determinations set forth in Graham v. John Deere Co., 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), and to provide a reason why one having ordinary skill in the pertinent art would have been led to modify the prior art or to combine prior art references to arrive at the claimed invention. Such reason must stem from some teaching, suggestion or implication in the prior art as a whole or knowledge generally available to one having ordinary skill in

the art. Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir.), cert. denied, 488 U.S. 825 (1988); Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985), cert. denied, 475 U.S. 1017 (1986); ACS Hosp. Sys., Inc. v. Montefiore Hosp., 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). These showings by the examiner are an essential part of complying with the burden of presenting a prima facie case of obviousness. Note In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). If that burden is met, the burden then shifts to the applicant to overcome the prima

facie case with argument and/or evidence. Obviousness is then determined on the basis of the evidence as a whole and the relative persuasiveness of the arguments. See Id.; In re Hedges, 783 F.2d 1038, 1039, 228 USPQ 685, 686 (Fed. Cir. 1986); In re Piasecki, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984); and In re Rinehart, 531 F.2d 1048, 1052, 189 USPQ 143, 147 (CCPA 1976). Only those arguments actually made by appellant have been considered in this decision. Arguments which appellant could have made but chose not to make in the brief have not been considered [see 37 CFR § 1.192(a)].

With respect to representative, independent claim 20, the examiner indicates how the claim recitations are met by the teachings of the Feature Guide [rejection mailed July 10, 1998, pages 3-4]. The examiner notes that the Feature Guide does not explicitly show the list of parameters for sorting displayed within the query dialog box, but instead, the Feature Guide shows a sort button for presumably calling up an additional sort window. The examiner determines that it would have been obvious to the artisan to combine the contents of

plural windows into a single window based on conventional tradeoffs of window complexity and ease of use. The examiner also finds that it would have been obvious to the artisan to designate a parameter value for each of the displayed parameters [id., pages 4-5 and answer, pages 5-7].

Appellant makes the following arguments: 1) The program represented by the Feature Guide is not designed to run in real time; 2) The Feature Guide does not enable a user to designate parameter values and to select a sort order within a single dialog box; 3) The Feature Guide does not teach how to create new filters or edit present filters; 4) The Feature Guide would require more complicated actions by the user to achieve the same results as appellant's invention; 5) The Feature Guide's use of plural windows teaches away from appellant's use of a single window; 6) the examiner's proposed modification to the Feature Guide program would render the Feature Guide program unsatisfactory for its intended purpose [brief, pages 12-24]; and 7) The motivation cited by the examiner is based on

improper hindsight [reply brief].

After a careful review of the entire record before us, we agree with the position argued by appellant. Although we do not agree with all of appellant's arguments noted above, we do agree with the argument numbered 2) above and find it to be dispositive of this appeal.

The independent claims recite that the query dialog box displays a plurality of parameters associated with the text data objects, values for these parameters and a space for selecting a sort order from the displayed parameters. The examiner views the invention as basically nothing more than the screen shown on page 86 of the Feature Guide with the sort button of that screen replaced by whatever screen is brought up by pressing the sort

button. In other words, the examiner views the invention as a trade off between clutter within a given screen or window and the use of additional screens or windows. We are of the view that the claimed invention requires more than this mere substitution based on clutter.

The sort button is labeled “K” in the Feature Guide and “K” is identified as “To specify a sort order for tasks in the report, choose this button” [page 86]. If one looks to the various task reports set out in the Feature Guide, one can see that the type of information listed on these task reports is not the same information as shown in the edit task report box on page 86. Thus, the types of parameters upon which tasks in the task reports can be sorted are not related to the items set forth as “A” to “G” in the edit task report box shown on page 86. Therefore, a key feature of the claimed invention is not present in the prior art as applied by the examiner. More particularly, the query dialog box of the claimed invention is not met by the edit task report box of the Feature Guide because the parameters designated by the examiner are not parameters upon which a sort is based as required by the claimed invention. The parameters to be sorted, their values and their sort order must all appear within the query dialog box. The edit task report box on page 86 of the Feature Guide does not show any of these items.

Since we find that the examiner has not properly

identified all the differences between the claimed invention and the Feature Guide, and since he has not, therefore, addressed the obviousness of these differences, we find that the examiner has not properly established a prima facie case of obviousness. Accordingly, we do not sustain the examiner's rejection of the appealed claims under 35 U.S.C. § 103. Therefore, the decision of the examiner rejecting claims 2-9, 11-18 and 20-22 is reversed.

REVERSED

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| JERRY SMITH<br>Administrative Patent Judge | ) | |
| MICHAEL R. FLEMING<br>Administrative Patent Judge | ) | BOARD OF PATENT APPEALS AND INTERFERENCES |
| JOSEPH F. RUGGIERO<br>Administrative Patent Judge | ) | |

JS/ki

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Application 08/561,178

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